

Office Action Summary

Application No.

10/792,038

Applicant(s)

RATH ET AL.

Examiner

Hoa V. Le

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,10,14,15,17-21,24-31,33-35,39,43-50,53-57 and 59 is/are pending in the application.
- 4a) Of the above claim(s) 7,14,24-31,33-35,39,43-50,54,55,58 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,10,15,17-21,53 and 56 is/are rejected.
- 7) ☒ Claim(s) 57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

FROM: P.THERATT with status 121 on 11/12/09
Applicant receives the Office action by fax
on 11/12/09

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le

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This is in response to Appeal Brief filed on 10/20/09.

I. Appeal Brief filed on 10/20/09 is nonresponsive because the record is incomplete. The record shows that applicant fails to try to overcome the issue of the double patenting rejection of the claims on the record by either (1) properly and timely filing a terminal disclaimer in order for an expert to timely check and approve before an allowance is considered and indicated or (2) properly and timely provide an argument for a proper and timely consideration for an early allowance of the claims.

II. The exhibits or evidences of:

$$1 \text{ wt\% TMAH}$$

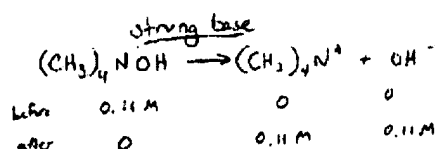
$$\text{assume } 100 \text{ g of solution}$$

$$\frac{1 \text{ g TMAH}}{91.15 \text{ g}} \times 1 \text{ mole} = 0.011 \text{ moles TMAH}$$

$$\text{assume density of } 1 \text{ wt\% TMAH} = 1 \text{ g/mL}$$

$$\frac{100 \text{ g } 1 \text{ wt\% TMAH}}{1 \text{ g}} = 100 \text{ mL}$$

$$\text{Molarity TMAH} = \frac{0.011 \text{ moles}}{0.1 \text{ L}} = 0.11 \text{ M}$$



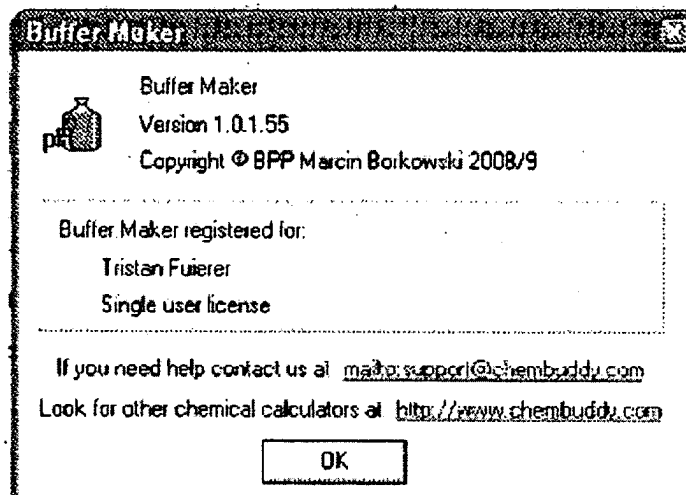
$$[\text{OH}^-] = 0.11 \text{ M}$$

$$\text{pOH} = 0.95$$

$$\text{pH} = 13.05$$

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on page 9;



on page 10;

pH = 8.00

at temperature 25 °C

lactic acid-TMAH

Conc. acid = 0.05 M (total)

ionic strength = 0.05000

Prepared by ...

Thursday, August 27, 2009

To make 1 L of above solution mix:

50.00 mL of 1.000M lactic acid + lactate

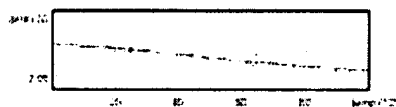
50.00 mL of 1.000M TMAH (TMAOH)

Fill up to 1 L

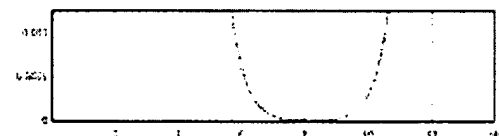
If preparing by titration @ 25 °C titrate to pH = 8.00

Remember to check and - if necessary - adjust pH of your buffer!

Buffer pH vs temperature plot



Buffer capacity vs pH plot



Buffer capacity ranges

adding strong acids/bases to:

- 100 mL, pH = 6.00
- 50 mL, pH = 7.00
- 100 mL, pH = 8.00
- make a buffer, pH = 8.00

adding strong acids/bases to:

- 100 mL, pH = 10.00
- 50 mL, pH = 11.00
- 100 mL, pH = 12.00

pH = 9.00

at temperature 25 °C

lactic acid-TMAH

Conc. acid = 0.05 M (total)

ionic strength = 0.05001

Prepared by ...

Thursday, August 27, 2009

To make 1 L of above solution mix:

50.00 mL of 1.000M lactic acid + lactate

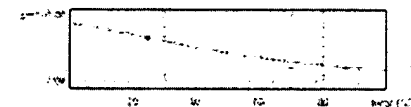
50.00 mL of 1.001M TMAH (TMAOH)

Fill up to 1 L

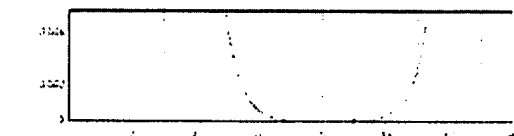
If preparing by titration @ 25 °C titrate to pH = 9.00

Remember to check and - if necessary - adjust pH of your buffer!

Buffer pH vs temperature plot



Buffer capacity vs pH plot



Buffer capacity ranges

adding strong acids/bases to:

- 100 mL, pH = 6.00
- 50 mL, pH = 7.00
- 100 mL, pH = 8.00
- make a buffer, pH = 9.00

adding strong acids/bases to:

- 100 mL, pH = 10.00
- 50 mL, pH = 11.00
- 100 mL, pH = 12.00

on page 11 and

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pH = 10.00

at temperature 25 °C

lactic acid-TMAH

lactic acid = 0.05 M (total)

ionic strength = 0.05025

Prepared by: [illegible]

Thursday, August 27, 2009

To make 1 L of above solution mix:

50.00 mL of 1.000M lactic acid (molecular)

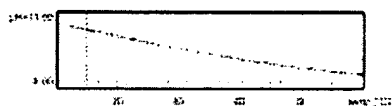
50.10 mL of 1.000M TMAH (TMAOH)

Fill up to 1 L

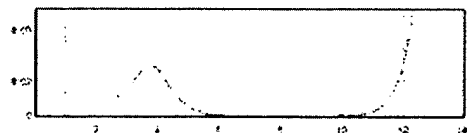
If preparing by titration @ 25 °C, titrate to pH = 10.00

Remember to check and - if necessary - adjust pH of your buffer!

Buffer pH vs temperature plot



Buffer capacity vs pH plot



1. Lower pH ranges

adding strong strong base:

1.000M, pH = 4.00

1.000M, pH = 7.00

1.000M, pH = 9.00

1.000M, pH = 10.00

adding strong strong base:

1.000M, pH = 10.00

1.000M, pH = 11.00

1.000M, pH = 12.00

pH = 11.00

at temperature 25 °C

lactic acid-TMAH

lactic acid = 0.05 M (total)

ionic strength = 0.05025

Prepared by: [illegible]

Thursday, August 27, 2009

To make 1 L of above solution mix:

50.00 mL of 1.000M lactic acid (molecular)

51.29 mL of 1.000M TMAH (TMAOH)

Fill up to 1 L

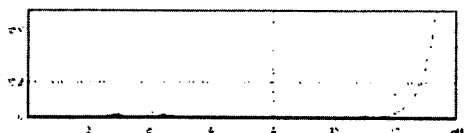
If preparing by titration @ 25 °C, titrate to pH = 11.00

Remember to check and - if necessary - adjust pH of your buffer!

Buffer pH vs temperature plot



Buffer capacity vs pH plot



1. Lower pH ranges

adding strong strong base:

1.000M, pH = 4.00

1.000M, pH = 7.00

1.000M, pH = 9.00

1.000M, pH = 10.00

adding strong strong base:

1.000M, pH = 10.00

1.000M, pH = 11.00

1.000M, pH = 12.00

On page 12 must be properly listed under "Evidence Appendix".

III. Evidences on pages 11 and 12 are mostly unreadable. Accordingly, readable evidences must be provided for a full, complete and proper consideration.

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IV. Applicant is given one time of one month only from the date of receiving this Office Action to file a new, readable, proper, full and complete appeal brief (when there is no terminal disclaimer being filed prior to or at the same time with filling of the new brief) without paying a fee. Otherwise, an extension of time will be calculated and charged. In this case, a proper fee payment must be on the record before considering of the newly filed appeal brief. After six months from receiving date of this Office Action, A note of abandonment will be sent to applicant. It is now, timely and clearly pointed out and set forth the record.

V. On 11/12/09, the issues in this Office Action have been presented, discussed and authorized by Supervisors and Specialists Jill A. Warden (571-272-1267) and Patrick J. Ryan (571-272-1292).

VI. There have been two rejections in the Final Office Action on the record mailed on 02/24/09 prior to Appeal Briefs being filed as:

(1). The statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

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Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-6, 10, 15, 17-21, 53 and 56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6, 12-17, 33-36, 39, 42-47 as amended on 01/10/08 of copending Application No. 10/389,214 (and its teachings and suggestions in the specification on at least paragraphs 9, 12, 13, 17, 18, 21, 23, Examples 2, 4 and 5. However, applicants, assignee and their counsel may and should disagree, urge and state on and for the record that each of the claims as originally filed is self sufficient. There has not been and will not be relied on any embodiment and any application for any purpose) considered in view of En et al ((2004/0134682) as a secondary reference):

Applicants in the applied broad claims with "comprising" and the broad teachings and/or suggestion in their specification are related to a cleaning composition containing chemical ingredients and their amounts as those in the

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instant claims. But, applicants in the applied broad claims with “comprising” and the broad teachings and/or suggestion do not specify an alkali base.

However, it is known in the art at the time the invention was made to obtain and use an alkali base for the advantage of providing a sufficient alkalinity and stripping power. Evidence can be seen in at least En et al at paragraph 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774.

Since the above references are all related to cleaners, stripper and/or removers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite potassium hydroxide alkaline agent for a reasonable expectation of sufficiently providing an additional alkalinity and stripping power to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(2). The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-5, 10, 15, 19-20 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koito et al (2003/0130147) considered in view of En et al (2004/0134682) or Sato et al (5,849,467).

Koito et al disclose, teach and suggest a cleaning (stripping and removing) composition of an unwanted material. The composition comprises a quaternary base and adenine. Please see the whole disclosure, especially on paragraphs 0031, 0045, 0077, 0085.

Koito et al do not specify an alkali base. However, it is known in the art at the time the invention was made to obtain and use an alkali base for the advantage of providing a sufficient alkalinity and stripping power. Evidence can be seen in at least En et al at paragraph 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774 or in Sato et al on at least on col.3:52 to 4:61, 5:41-48, 7:34-48, Examples 1, 5 and 8.

Since the above references are all related to cleaners, removers and/or strippers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite potassium hydroxide alkaline agent for a reasonable expectation of sufficiently providing an additional alkalinity and stripping power to one having ordinary skill in the art.

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The above rejections are reproduced as the reminders but not new or reopen the prosecution.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, one of the supervisors: Mark Huff can be reached on 571-272-1385 and Supervisors and Specialists Jill A. Warden (571-272-1267) and Patrick J. Ryan (571-272-1292). The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hoa V. Le/

Primary Examiner, Art Unit 1795

111209

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PRIMARY EXAMINER



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COMMENTS

APPLICATION NO. 10/792,038